

**PATENT  
APPLICATION 10/748,959  
ATTORNEY DOCKET 2003-0009 (1014-053)**

**REMARKS**

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1, 4, and 16-20 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 is in independent form.

**I. The Obviousness Rejections**

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable over various combinations of WIPO Patent 01/17219 ("Hjartarson"), a paper entitled "an independent evaluation of the performance of the CCITT G.722 wide band coding recommendation" ("Smyth"), a paper entitled "Design and Implementation of AC-3 Coders ("Vernon"), a paper entitled "Session Initiation Protocol (SIP)-H.323 Interworking Requirements" ("Schulzrinne"), U.S. Patent 6,381,238 ("Hluchyj"), and/or U.S. Patent 7,164,694 ("Nodoushani"). Each of these rejections is respectfully traversed.

**A. Legal Standards**

**1. *Prima Facie* Criteria for an Obviousness Rejection**

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."

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Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (2007), the Supreme Court interpreted this law while highlighting the typical invention process. “Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known” (emphasis added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. “Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility” (emphasis added).

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Regarding proposed combinations of prior art, *KSR* clarified that the “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”. Thus, in determining obviousness, both *KSR* and *Graham* warned against a “temptation to read into the prior art the teachings of the invention in issue” and instruct to ““guard against slipping into the use of hindsight””.

*KSR* further warned, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. The Federal Circuit has held that “[w]hen there is a design need or market pressure to solve a problem”, obviousness is not supported unless “a finite, and in the context of the art, small or easily traversed, number of options” “would convince an ordinarily skilled artisan of obviousness”. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, \_\_\_ F.3d \_\_\_, 2008 WL 834402 (Fed. Cir. 2008).

To guard against hindsight, *KSR* explained the “import[ance]” of “identify[ing] a reason that would have prompted a person of ordinary skill in the relevant field to combine the

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elements in the way the claimed new invention does" (emphasis added). That is, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness" (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, "[t]o facilitate review, this analysis should be made explicit".

Explaining the need for "a reason that would have prompted a person of ordinary skill", *KSR* further taught that "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill" (emphasis added). Further exploring this mandate, the Federal Circuit has recently recognized that "knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references". *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" and must present substantial evidence that one of ordinary skill **WOULD** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **MUST BE** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g*

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*denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

## **2. Unfounded Assertions of Knowledge**

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

## **3. All Words in a Claim Must Be Considered**

“To establish *prima facie* obviousness..., ‘[a]ll words in a claim must be considered’”. MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

## **4. Interpreting “adapted”**

The predecessor court to the Federal Circuit has interpreted the phrase “adapted” as preceding a “structural limitation”. *See, In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by “adapted” have been considered sufficiently definite. *See* MPEP

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2173.05(g).

In addition, the Federal Circuit has interpreted the word “adapted” as preceding “functional language [that] limits the scope of these claims to devices that have the capability of” performing the stated function. *See, R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term “adapted.”

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated “said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive ... layer has occurred.” *See, In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the functional limitations.

In yet another case, the Federal Circuit reversed an Examiner’s rejection of a patent claim due to the Examiner’s failure to provide patentable weight to functional limitations. *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

### 5. Determination of the Level of Skill

Consistent with Graham, “the level of ordinary skill in the art is a factual question that must be resolved and considered.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Id.* Thus, the “examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and ‘not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand.’” MPEP 2141.03, quoting *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

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**6. The Applied Reference(s) Must Be Enabling**

"In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." *Rockwell Int'l Corp. v. U.S.*, 147 F.2d 1358, 47 USPQ2d 1027 (Fed. Cir. 1998); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

**7. Next Office Action**

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. See, *In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

**B. Analysis**

**1. Claim 1**

**a. Prima Facie Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

**b. Missing Claim Limitations**

As an initial matter, the rejection of claim 1 is traversed as moot in view of the present amendments to claim 1. Specifically, claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied

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portions of Hjartarson teach, "automatically determining that customer premises equipment accommodates a Dolby Digital AC-3 signal". Moreover, claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "responsive to said determination that customer premises equipment accommodates said Dolby Digital AC-3 signal, automatically substituting a Dolby Digital AC-3 codec for the G.722 codec". In addition, claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "running said Dolby Digital AC-3 codec on a digital signal processor installed on the subscriber interface line card".

No substantial evidence has been presented that the applied portions of the remaining relied-upon references cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

**c. Failure to Consider All Words of Claim 1**

The present Office Action asserts, at Page 4:

[i]t has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

With all due respect, this assertion is contrary to law. *In re Hutchison* was decided 20 years prior to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and thus, could not have used the obviousness criteria established by *Graham*. In over 60 years since *In re*

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*Hutchison* was decided, no appellate court has cited *In re Hutchison* as authority for a premise that “an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense”, as asserted by the present Office Action. For at least these reasons, *In re Hutchison* is no longer valid law in view of *Graham* and subsequent case law regarding the claim phrase “adapted”.

The assertions of the present Office Action regarding limitations preceded by the words “adapted to” have no legal basis whatsoever. At least the cases of *In re Venezia, R.A.C.C. Indus., Inc.*, and *In re Land* represent binding authority that limitations following the phrase “adapted to” are patentable limitations.

**d. Lack of Required Factual Evidence of Obviousness**

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what “the pertinent art” is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

**e. Lack of Evidence of a Reason to Combine References**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Hjartarson, Smyth, Vernon, and Schulzrinne, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, Vernon, and Schulzrinne, that are used in rejecting claim 1 in such a manner so as to arrive at the claimed subject matter of claim 1. Regarding the proffered combination of Hjartarson, Smyth, Vernon, and Schulzrinne the present Office Action states, at Pages 3-4:

it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the G.722 codec and AC-3 codec, as taught by Smyth and Vernon, into the line card (specifically 24 or 46, Hjartarson: page 9, lines 21-25)

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of Hjartarson for the purpose of providing high quality voice signals and enhancing the performance of the transmitted signals.

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed, number of options" that "would convince an ordinarily skilled artisan of obviousness". Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 1 cannot be sustained based upon the mere conclusory statements of the present Office Action.

**f. Hjartarson Not Enabling**

Claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson enables, "the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722".

**g. Conclusion**

For at least these reasons, reconsideration and withdrawal of the rejection of claim 1 is respectfully requested. Also, reconsideration and withdrawal of each rejection of each of claims 2-18, each ultimately depending from independent claim 1, is respectfully requested.

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**2. Claim 4**

The rejection of claim 4 is traversed as moot in view of the present amendments to claim 4. Specifically, claim 4, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the line card adapted to append an address header to signals transmitted to a subscriber loop circuit". For at least these reasons, reconsideration and withdrawal of the rejection of claim 4 is respectfully requested.

**3. Claim 7**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

Claim 7, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to switch automatically between the codec specified in G.722 and a POTS codec based upon capabilities of customer premises equipment". The present Office Action alleges that this claimed subject matter is present at page 6, lines 12-21 of Hjartarson. Yet this applied portion of Hjartarson is completely silent regarding any ability to switch automatically between any two codecs and is further silent regarding a G.722 codec.

No substantial evidence has been presented that the applied portions of the remaining relied-upon references cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 7 is respectfully requested.

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**4. Claim 8**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

Claim 8 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to switch automatically between the codec specified in G.722 and a POTS codec based upon network capabilities". The present Office Action alleges that this claimed subject matter is present at page 6, lines 12-21 of Hjartarson. Yet this applied portion of Hjartarson is completely silent regarding any ability to switch automatically between any two codecs and is further silent regarding a G.722 codec.

No substantial evidence has been presented that the applied portions of the remaining relied-upon references cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 8 is respectfully requested.

**5. Claim 10**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, and Hluchyj, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, Vernon, Schulzrinne, and Hluchyj, that are used in rejecting claim 10 in such a manner so as to arrive at

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the claimed subject matter of claim 10. Regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, and Hluchyj the present Office Action states, at Page 7:

it would have been obvious to a person of ordinary skill in the art at the time of the invention to transcode between G.722 and LD-CELP, as taught by Hluchyj, for the purpose of achieving high efficiency and low delay at the same time in order to fulfill the requirement needs of digital telephony under International Telecommunication Union (ITU).

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed, number of options" that "would convince an ordinarily skilled artisan of obviousness". Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 10 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 10 is respectfully requested.

#### **6. Claim 11**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, and Hluchyj with Nodoushani, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, Vernon, Schulzrinne, Hluchyj, and Nodoushani, that are used in rejecting claim 11 in such a manner so as to arrive at the claimed subject matter of claim 11. Regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, Hluchyj, and Nodoushani the present Office Action states, at Pages 7-8:

it would have been obvious to the person of ordinary skill in the art at the time of the invention to implement the method of converting out of band analog signals to out of band packets, as taught by Nodoushani, into the telecommunication system of Hjartarson. The motivation for utilizing the conversion method taught by Nodoushani within the telecommunication system of Hjartarson being that it will allow the system to have a dedicated channel for control signals and allow communication between VOIPA/OATM network and none VOIPA/OATM network, such as PSTN.

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed, number of options" that "would convince an ordinarily skilled artisan of obviousness". Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion

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of obviousness. The rejection of claim 11 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 11 is respectfully requested.

**7. Claim 12**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, and Hluchyj with Nodoushani, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, Vernon, Schulzrinne, Hluchyj, and Nodoushani, that are used in rejecting claim 12 in such a manner so as to arrive at the claimed subject matter of claim 12. Regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, Hluchyj, and Nodoushani the present Office Action states, at Pages 7-8:

it would have been obvious to the person of ordinary skill in the art at the time of the invention to implement the method of converting out of band analog signals to out of band packets, as taught by Nodoushani, into the telecommunication system of Hjartarson. The motivation for utilizing the conversion method taught by Nodoushani within the telecommunication system of Hjartarson being that it will allow the system to have a dedicated channel for control signals and allow communication between VOIPA/OATM network and none VOIPA/OATM network, such as PSTN.

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed, number of options" that "would convince an ordinarily skilled artisan of obviousness". Moreover, the present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would

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have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 12 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 12 is respectfully requested.

#### **8. Claim 13**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, and Hluchyj with Nodoushani, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, Vernon, Schulzrinne, Hluchyj, and Nodoushani, that are used in rejecting claim 13 in such a manner so as to arrive at the claimed subject matter of claim 13. Regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, Hluchyj, and Nodoushani the present Office Action states, at Pages 7-8:

it would have been obvious to the person of ordinary skill in the art at the time of the invention to implement the method of converting out of band analog signals to out of band packets, as taught by Nodoushani, into the telecommunication system of Hjartarson. The motivation for utilizing the conversion method taught by Nodoushani within the telecommunication system of Hjartarson being that it will allow the system to have a dedicated channel for control signals and allow

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communication between VOIPA/OATM network and none VOIPA/OATM network, such as PSTN.

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed, number of options" that "would convince an ordinarily skilled artisan of obviousness". Moreover, the present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 13 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 13 is respectfully requested.

#### 9. Claim 14

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, and Hluchyj with Nodoushani, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth,

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Vernon, Schulzrinne, Hluchyj, and Nodoushani, that are used in rejecting claim 14 in such a manner so as to arrive at the claimed subject matter of claim 14. Regarding the proffered combination of Hjartarson, Smyth, Vernon, Schulzrinne, Hluchyj, and Nodoushani the present Office Action states, at Page 8:

it would have been obvious to the person of ordinary skill in the art at the time of the invention to implement the method of converting voice band signal associated with the analog signals to out of band packets, as taught by Nodoushani, into the telecommunication system of Hjartarson. The motivation for utilizing the conversion method taught by Nodoushani within the telecommunication system of Hjartarson being that it will allow the system to have a dedicated channel for control signals and allow communication between VOIPA/OATM network and none VOIPA/OATM network, such as PSTN.

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed, number of options" that "would convince an ordinarily skilled artisan of obviousness". Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 14 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 14 is respectfully requested.

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**10. Claim 16**

The rejection of claim 16 is traversed as moot in view of the present amendments to claim 16. Specifically, claim 16, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the subscriber interface line card adapted to receive a signal indicative of a highest possible bearer bandwidth and codec that a network is capable of supporting, said Dolby Digital AC-3 codec selected based upon said signal indicative of said highest possible bearer bandwidth and codec". For at least these reasons, reconsideration and withdrawal of the rejection of claim 16 is respectfully requested.

**11. Claim 17**

The rejection of claim 17 is traversed as moot in view of the present amendments to claim 17. Specifically, claim 17, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the subscriber interface line card adapted to interwork with ISDN to negotiate bearer capabilities between calling and called parties". For at least these reasons, reconsideration and withdrawal of the rejection of claim 17 is respectfully requested.

**12. Claim 18**

The rejection of claim 18 is traversed as moot in view of the present amendments to claim 18. Specifically, claim 18, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the subscriber interface line card adapted to receive a response to a query of a server, the query to the server to determine if a terminating subscriber is an enhanced services subscriber". For at least these reasons, reconsideration and withdrawal of the rejection of claim 18 is respectfully requested.

**13. Claim 19**

**a. Prima Facie Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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**b. Missing Claim Limitations**

As an initial matter, the rejection of claim 19 is traversed as moot in view of the present amendments to claim 19. Specifically, claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to receive a signal that customer premises equipment accommodates a Dolby Digital AC-3 signal". Moreover, claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the Dolby Digital AC-3 codec stored on the subscriber interface line card, the Dolby Digital AC-3 codec adapted to run on a digital signal processor coupled to the POTS subscriber loop circuit interface, the Dolby Digital AC-3 codec adapted to encode the plurality of digital samples".

No substantial evidence has been presented that the applied portions of the remaining relied-upon references cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

**c. Failure to Consider All Words of Claim 19**

The present Office Action asserts, at Page 4:

[i]t has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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With all due respect, this assertion is contrary to law. *In re Hutchison* was decided 20 years prior to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and thus, could not have used the obviousness criteria established by *Graham*. In over 60 years since *In re Hutchison* was decided, no appellate court has cited *In re Hutchison* as authority for a premise that "an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense", as asserted by the present Office Action. For at least these reasons, *In re Hutchison* is no longer valid law in view of *Graham* and subsequent case law regarding the claim phrase "adapted".

The assertions of the present Office Action regarding limitations preceded by the words "adapted to" have no legal basis whatsoever. At least the cases of *In re Venezia, R.A.C.C. Indus., Inc.*, and *In re Land* represent binding authority that limitations following the phrase "adapted to" are patentable limitations.

**d. Lack of Required Factual Evidence of Obviousness**

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

**e. Lack of Evidence of a Reason to Combine References**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Hjartarson, Smyth, Vernon, and Schulzrinne, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, Vernon, and Schulzrinne, that are used in rejecting claim 19 in such a manner so as to arrive at the claimed subject matter of claim 19. Regarding the proffered combination of Hjartarson, Smyth, Vernon, and Schulzrinne the present Office Action states, at Pages 3-4:

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it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the G.722 codec and AC-3 codec, as taught by Smyth and Vernon, into the line card (specifically 24 or 46, Hjartarson: page 9, lines 21-25) of Hjartarson for the purpose of providing high quality voice signals and enhancing the performance of the transmitted signals.

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are “a finite, and in the context of the art, small or easily traversed, number of options” that “would convince an ordinarily skilled artisan of obviousness”. Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 19 cannot be sustained based upon the mere conclusory statements of the present Office Action.

**f. Hjartarson Not Enabling**

Claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson enables, “the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722, the line card adapted to automatically substitute a Dolby Digital AC-3 codec for the G.722 codec”.

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**g. Conclusion**

For at least these reasons, reconsideration and withdrawal of the rejection of claim 19 is respectfully requested.

**14. Claim 20**

**a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

**b. Missing Claim Limitations**

As an initial matter, the rejection of claim 20 is traversed as moot in view of the present amendments to claim 20. Specifically, claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "automatically determining that customer premises equipment accommodates a Dolby Digital AC-3 signal". Moreover, claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "responsive to said determination that customer premises equipment accommodates said Dolby Digital AC-3 signal, automatically substituting a Dolby Digital AC-3 codec for the G.722 codec". In addition, claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "running said Dolby Digital AC-3 codec on a digital signal processor installed on the subscriber interface line card".

No substantial evidence has been presented that the applied portions of the remaining relied-upon references cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case

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of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

**c. Failure to Consider All Words of Claim 20**

The present Office Action asserts, at Page 4:

[i]t has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

With all due respect, this assertion is contrary to law. *In re Hutchison* was decided 20 years prior to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and thus, could not have used the obviousness criteria established by *Graham*. In over 60 years since *In re Hutchison* was decided, no appellate court has cited *In re Hutchison* as authority for a premise that "an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense", as asserted by the present Office Action. For at least these reasons, *In re Hutchison* is no longer valid law in view of *Graham* and subsequent case law regarding the claim phrase "adapted".

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**d. Lack of Required Factual Evidence of Obviousness**

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

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**e. Lack of Evidence of a Reason to Combine References**

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Hjartarson, Smyth, Vernon, and Schulzrinne, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, Vernon, and Schulzrinne, that are used in rejecting claim 20 in such a manner so as to arrive at the claimed subject matter of claim 20. Regarding the proffered combination of Hjartarson, Smyth, Vernon, and Schulzrinne the present Office Action states, at Pages 3-4:

it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the G.722 codec and AC-3 codec, as taught by Smyth and Vernon, into the line card (specifically 24 or 46, Hjartarson: page 9, lines 21-25) of Hjartarson for the purpose of providing high quality voice signals and enhancing the performance of the transmitted signals.

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed, number of options" that "would convince an ordinarily skilled artisan of obviousness". Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 20 cannot be sustained based upon the mere conclusory statements of the present Office Action.

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**f. Hjartarson Not Enabling**

Claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson enables, "the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722".

**g. Conclusion**

For at least these reasons, reconsideration and withdrawal of the rejection of claim 20 is respectfully requested.

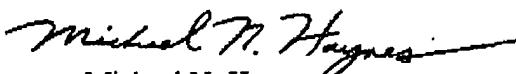
**CONCLUSION**

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Michael N. Haynes

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